

REMARKS

1. Summary of the Rejections in the Office Action of July 15, 2003

At page 1, spanning paragraphs 3 and 4 of the Office Action, the Examiner rejects claims 26, 32, 36, and 40 under 35 U.S.C. § 112, ¶1, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. At page 2, paragraph 5 of the Office Action, the Examiner rejects claims 26-43 under 35 U.S.C. § 103(a), as allegedly being obvious in view of U.S. Patent No. 5,913,215 to Rubenstein et al. ("Rubenstein") and U.S. Patent No. 6,061,738 to Osaku et al. ("Osaku").

2. 35 U.S.C. § 112, ¶1 Rejections

At page 1, spanning paragraphs 3 and 4 of the Office Action, the Examiner rejects claims 26, 32, 36, and 40 under 35 U.S.C. § 112, ¶1, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner alleges that the phrase: "without accessing a remote search engine" is an improper negative limitation, and also is not supported by the original specification. The Examiner also alleges that the phrase: "a subject index nested within said verb index, and a provider index nested within said subject index," is not supported by the original specification.

The Applicant respectfully TRAVERSES the Examiner's new subject matter rejections and asserts the following remarks in response:

By way of this paper, the Applicant amends claims 26, 32, 36, and 40 to remove the phrase: "without accessing a remote search engine" from these claims. Therefore, the new matter rejections of claims 26, 32, 36, and 40 with respect to the phrase: "without accessing a remote search engine" now are moot and need no further response.

Applicant also maintains that the phrase: "a subject index nested within said verb index, and a provider index nested within said subject index," is fully supported by the original specification. Specifically, the term "nested," as applied to the subject matter of the present invention, may be defined as "a subroutine or a set of data contained sequentially within another subroutine or another set of data." Webster's II New College Dictionary, 734 (2001) (hereinafter "Webster's"). Moreover, a second subroutine is nested within a first subroutine when the first subroutine "calls" the second subroutine. The Applicant's original specification includes exemplary software code which may be used to facilitate the Applicant's claimed invention. See, e.g., Appl'n, Page 13, Lines 20-43; Page 14, Lines 1-32 and 21-54; and Page 15, Lines 1-37.

The Applicant maintains that based on the exemplary software code included in the Applicant's original specification, those of ordinary skill in the art readily will understand that the subject index is nested within the verb index, and the provider index is nested within the subject index. Specifically, those of ordinary skill in the art readily will understand that the subroutine associated with the verb index "calls" the subroutine associated with the subject index. See, e.g.,

Id. at Page 14, Lines 41-54; and Page 15, Lines 1-8. For example, during a user search session, the subjects which are available for user selection **depends on the verb which the user previously selected**. (Emphasis added.) Similarly, those of ordinary skill in the art readily will understand that the subroutine associated with the subject index “calls” the subroutine associated with the provider index. See, e.g., Id. at Page 14, Lines 48-54; and Page 15, Lines 1-37. For example, during a user search session, the providers which are available for user selection **depends on the subject which the user previously selected**. (Emphasis added.) Therefore, the Applicant respectfully requests that the Examiner withdraw the new matter rejections of claims 26, 32, 36, and 40 with respect to the phrase: “a subject index nested within said verb index, and a provider index nested within said subject index.”

3. **35 U.S.C. § 103(a) Rejections**

At page 2, paragraph 5 of the Office Action, the Examiner rejects claims 26-43 under 35 U.S.C. § 103(a), as allegedly being obvious in view of Rubenstein and Osaku.

The Applicant respectfully TRAVERSES the Examiner’s obviousness rejections and asserts the following remarks in response:

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable

expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143 (emphasis added). The Applicant maintains that the Examiner fails to establish a prima facie case for obviousness because the Examiner fails to satisfy his burden of showing that the combination of Rubenstein and Osaku discloses or suggests all of the claimed limitations of claims 26-43.

a. Independent Claims 26, 32, 36, and 40

The Applicants' independent claims 26, 32, 36, and 40 each include the limitation of "a hierarchal organization that includes a verb index, a subject index nested within said verb index, and a provider index nested within said subject index." (Emphasis added.) At paragraph 5, spanning pages 2-4 of the Office Action, the Examiner alleges several times that Rubenstein includes a verb index, a subject index, and a provider index. Nevertheless, the Examiner does not allege that either Rubenstein or Osaku discloses or suggests that the subject index is nested within the verb index. Similarly, the Examiner does not allege that either Rubenstein or Osaku discloses or suggests that the provider index is nested within the subject index. Therefore, the Examiner fails to satisfy his burden of establishing a prima facie case for obviousness because the Examiner fails to show that the combination of Rubenstein and Osaku discloses or suggests "a hierarchal organization that includes a verb index, a subject index nested within said verb index, and a provider index nested within said subject index," as set forth in independent claims 26, 32, 36, and 40.

Moreover, the Applicant maintains that Rubenstein clearly does not disclose or suggest that the subject index is nested within the verb index, or that the provider index is nested within the subject index. For example, in Rubenstein, a computer-user is prompted to “construct a search expression, then [to] communicate the search expression to each of a plurality of search engines located at respective World Wide Web sites. Each of the plurality of search engines is prompted to concurrently identify a respective plurality of web pages containing text consistent with the search expression and to return a respective URL for each such web page identified.” Rubenstein, Abstract. The system of Rubenstein then identifies keyword phrases from these web pages, and automatically generates a list of the keyword phrases. The computer-user then constructs a keyword search expression from the list of the keyword phrases. See, e.g., Id. at Column 2, Lines 27-38. Nevertheless, none of the keyword phrases included in this list are nested within another keyword phrase in the list. For example, the selection of one keyword phrase does not in anyway affect the computer-user’s ability to subsequently select another of the keyword phrases. Consequently, the subroutine associated with one keyword phrase does not “call” the subroutine associated with another keyword phrase. Therefore, the Applicant respectfully requests that the Examiner withdraw the obviousness rejections of claims 26, 32, 36, and 40, and allow the same to issue in a U.S. patent.

b. Dependent Claims 27-31, 33-35, 37-39, and 41-43

Claims 27-31, 33-35, 37-39, and 41-43 depend from independent claims 26, 32, 36, and 40, respectively. “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.”

MPEP 2143.03 (citations omitted). Therefore, the Applicant respectfully requests that the Examiner also withdraw the obviousness rejections of claims 27-31, 33-35, 37-39, and 41-43, and allow the same to issue in a U.S. patent.

<THIS SPACE IS LEFT BLANK INTENTIONALLY>

CONCLUSION

The Applicant respectfully submits that the above-titled patent application is in condition for allowance, and such action is earnestly requested. If the Examiner believes that an in-person or telephonic interview with the Applicant's representatives will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney of record. The Applicant believes that no fees are due as a result of this submission. However, in the event of any variance between the fees determined the Applicants and those determined by the U.S. Patent and Trademark Office, please charge any such variance to the undersigned's Deposit Account No. 01-2300.

Respectfully submitted,

Arent Fox PLLC

By: 

Timothy J. Churna
Registration No. 48,340
FOR: Erik B. Cherdak
Registration No. 39,936

Arent Fox PLLC
1050 Connecticut Ave., N.W.
Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 857-8933
Facsimile No. (202) 857-6395
EBC/TJC:klf

Dated: 12/8/04